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EXAMINER	
BATTULA, PRADEEP CHOUDARY	
ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/691,264	CRUM, JESSE D.	
	Examiner	Art Unit	
	Pradeep C. Battula	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *7 - 9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08/02/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

 I. Claims 1 – 6 are drawn to a composite form assembly, Claims 10 – 16 are drawn to a peelable laminate, and Claims 17 – 20 are drawn to an in-situ cured laminated business form. All of the previous claims are classified in class 283, subclass 81.

 II. Claims 7 – 9 are, drawn to a method of communicating, classified in class 705, subclass 14.

2. The inventions are distinct, each from the other because of the following reasons:

 I. Inventions 1, 3 and 4 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product such as coupons from a newspaper.

 (a) Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Attorney Michael C. Maier on May 22, 2006 a provisional election was made without traverse to prosecute the inventions of a composite form assembly, a peelable laminate and an in-situ cured laminated business form, claims 1-6 and 10-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claims 18 – 20 are objected to because of the following informalities:

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claims 18 – 20 draw dependency to a peelable laminate in Claim 16 but in the claim they draw dependency to an in-situ cured laminate that draws dependency to Claim 17.

Specification

5. The disclosure is objected to because of the following informalities:

In Paragraph 37, Lines 3 – 5 the sentence states, "The curable coating 230 of the present invention is disposed between the first 210 and section 230 sheet of the

laminated business form construction." The item number 230 is referred as two different items.

In Paragraph 42, Line 3 there is a spelling error. The sentence states, "...machine finished paper having a thickness ranging form...." The word in question is "form" which seems to be a spelling error of the intended word "from". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 – 6 and 10 - 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "...application of ultraviolet energy through one of said first and second coatings..." is unclear since a second coating it is not disclosed previously.

Claims 2 – 6 depend upon rejected independent Claim 1 and therefore are rejected.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a second layer having a second thickness different than said first thickness and having first and second layers;" is unclear since the claim discloses that the second layer has a first and second layer which is not explained in the specifications or shown in the drawings.

Claims 11 – 16 depend upon rejected independent Claim 10 and are therefore rejected.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is disclosed in the abstract that a laminated form construction in which two or more layers are bonded together in-situ through use of a curable compound that creates a frangible bond between the layers which upon application of sufficient peeling pressure the form components or portions will separate from the composite form assembly. It is not clear to the examiner how the laminated form is adhesive free.

7. Claims 18 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18 – 20 disclose an in-situ cured laminated business form and depend from Claim 16 which depends from Claim 10. Claim 10 does not set forth an in-situ

cured laminated business form and, therefore, it is not clear to the examiner how Claims 18 – 20 further limit Claim 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lalande (U.S. 5,721,178).

Lalande disclose an in-situ cured laminated business form, comprising; a first layer 16 of material having first 17 and second faces (not numbered; Column 2, Lines 23 – 28); a second layer 11 of material having first 15 and second faces (not numbered; Column 2, Lines 15 – 20); at least one of said first and second layers having a series of die cuts formed therein to create a plurality of removable elements 13 (layer 16; Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j) and a curable coating applied to one of said first and second faces of each of said first and second layers corresponding to an area covered by said removable elements (Column 2, Lines 64 – 66; Column 3, Lines 6 – 8).

Additionally, in response to the in-situ curing, it is not disclosed how it will be done but as long as the assembly is not moving during curing then it is in-situ. The procedures that can be executed to accomplish this goal are routine in the art.

Furthermore, there is a product by process statement dictating "...cured in-situ by treatment energy passed through one of said first and second layers to form a

laminated..." Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113

In regards to Claim 18, as applied to Claim 17, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases "...used as an apparel, textile tag or combination thereof. " do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, the business form assembly of Lalande will produce the same business form that is described in Claim 17 of the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 2, 3, 4, 6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalande (U.S. 5,721,178) in view of Good (Kelly, U.S. 5,728,440

In regards to Claim 1, Lalande discloses a composite form assembly 10, comprising; a first layer 16 having first 17 and second surfaces (not numbered), at least one of said first and second surfaces capable of receiving printing 17 (Column 2, Lines 23 – 28, Figure 1, Items 10, 16, and 17). Lalande further discloses the first layer having a series of die cuts (Column 2, Lines 36 – 37; Figure 2, Item 26 [process step]) that divide said first layer into a number of removable elements 13 (Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j). Lastly, Lalande discloses that the second layer 11 having first 15 and second surfaces (not numbered) (Column 2, Lines 15 – 20) and said second layer is composed of a different material than said first layer (Claim 1 of Lalande); and a coating disposed between said first and second layers and provided in the area of at least said removable elements (Column 2, Line 24 – 25). The examiner considers each independent removable element as a major portion.

Lalande does not disclose the removable elements having a minor portion with said minor portion remaining with a second layer on removal of said major portion.

Good discloses, the removable elements having a major portion (not numbered) and a minor portion 15 with said minor portion remaining with a second layer 19 on removal of said major portion (Column 3, Lines 61 – 65; Figure 4, Item 19; Column 4,

Line 66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Good's die cut into the major portions 13 of Lalande in order to allow for the tag to be attached to clothes and consumer products, as taught by Lalande (Column 2, Lines 41 – 45), without having to stitch a tag onto an item.

Furthermore, regarding Claim 1, there is a product by process statement dictating "...wherein upon application of ultraviolet energy through one of said first and second coatings, said coatings form a frangible bond between said first and second layers." Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

The phrases "...used as an apparel, textile tag or combination thereof." do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, composite form assembly of Lalande altered by Good is the same composite form that is described in Claim 1.

Regarding Claim 2, as applied to Claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114.

In regards to Claim 3, as applied to Claim 1, Good discloses that the minor portion 15 is die cut (Column 3, Lines 61 – 65).

In regards to Claim 4, as applied to Claim 1, Lalande further discloses that silicone is adhered to the bottom side (not numbered) of the first layer 16 (Column 2, Line 24 – 28).

In regards to Claim 6, as applied to Claim 1, Lalande discloses that the first and second layers are different material and therefore possibly have different thickness. Also, Good discloses a thickness for the face stock 11 material (7 millimeters), which the tag 10 is made from, and the silicone coating (2.0 millimeters) release liner (Column 4, Lines 54 – 64). Lalande modified by Good discloses the claimed invention except for the second layer having a thickness of no more than about 7 millimeters. It would have been an obvious matter of design choice to determine a thickness for the second layer, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

In regards to Claim 10, Lalande a discloses peelable laminate 13 having a frangible bond, comprising; a first layer 16 having a first thickness and having first 17 and second surfaces (not numbered) with at least one of said first and second surfaces

receiving printing 17 (Column 2, Lines 23 – 28); a second layer 11 with a second thickness (Column 2, Lines 15 – 20) having first 15 and second surfaces (not numbered); a coating composition securing said first and second layers one to another upon application of a pressure treatment to form a seal, said treatment passing through one of said first and second layers to create said seal (Column 2, Lines 15 – 28;); and said first layer having a series of die cuts provided therein, said die cuts producing separable tags (Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j). The examiner considers each independent removable element as a major portion.

Lalande does not disclose that the two layers have different thicknesses nor does Lalande disclose that each of said tags has a minor portion, with said major portion having a surface area at least ten times greater than a surface area of said minor portion and wherein upon removal of said major portion from said first layer, said minor portion remains adhered to said first layer.

Good discloses each of said tags having a major portion and a minor portion 15, with said major portion 16 having a surface area greater than the surface area of said minor portion (Figure 1, Items 15, and 16) and wherein upon removal of said major portion from said first layer, said minor portion remains adhered to said first layer (Column 3, Lines 61 – 65). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Good's die cut into the major portions 13 of Lalande in order to allow for the tag to be attached to clothes and consumer products, as taught by Lalande (Column 2, Lines 41 – 45), without having to stitch a tag onto an item. In regards to the minor portion having a

surface area ten times smaller than that of the major portion one only needs to reduce the size of the cut and a change in size of a component is seen as only requiring routine skill in the art.

With respect to the first and second layer having different thicknesses it is disclosed in Lalande that the first and second layers are different material and therefore possibly have different thickness. Also Good discloses a thickness for the face stock 11 material, which the tag is made from, along with the silicone coating release liner (Column 4, Lines 54 – 64). Lalande modified by Good discloses the claimed invention except for the first and second layers having different thickness. It would have been an obvious matter of design choice to have the layers be a different thickness, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

In regards to Claim 12, as applied to Claim 10, Lalande discloses that the first layer 16 has a coating of silicone on the bottom surface (Column 2, Lines 24 – 28).

In regards to Claim 13, as applied to Claim 10, it is stated that removable items 13 will be printed on as they pass through a printer (Column 1, Lines 20 – 23) and it is therefore obvious that the peelable laminate is substantially planar since printers require substantially planar surfaces to be fed in order to prevent jamming and inaccuracies printing.

In regards to Claim 14, as applied to Claim 10, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases "...used to create apparel or textile tags, ski or lift tickets, entry or admission passes..." do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, composite form assembly of Lalande altered by Good as applied to Claim 10 will be able to perform the intended function.

In regards to Claim 15, as applied to Claim 10, applicant has failed to disclose the criticality of the thickness of the layers. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to vary the ranges of thickness in order to create a wide variety of uses. A large range would allow for use in personal printers to industrial printers, also the range would allow for users to use a layer of material that either provides a large amount of support or smaller amount of support. This would relevant when die cutting and for using a layer as a release ply.

9. Claims 5, 11, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalande (U.S. 5,721,178) in view of Good (U.S. 5,728,440) and in further view Tighe (U.S. 4,704,310).

In regards to Claim 5, as applied to Claim 1, it is not disclosed in Lalande or Good that there is ultraviolet radiation treatment for curing with the use of a gallium or H-bulb.

Tighe discloses an ultraviolet curable coating 30 in a heat transferable laminate (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 11, as applied to Claim 10, it is not disclosed in Lalande or Good that the treatment energy to cure the coating is ultraviolet.

Tighe discloses an ultraviolet curable coating 30 (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 16, as applied to Claim 10, neither Lalande nor Good disclose that the coating composition includes acrylated monomers and oligomers.

Tighe discloses that the coating 20, which creates a coating composition with coating 30, includes oligomers which would also include acrylated monomers (Column 7, Lines 28 – 31). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 19, as applied to Claim 17, it is not disclosed in Lalande or Good that the treatment energy to cure the coating is ultraviolet.

Tighe discloses an ultraviolet curable coating 30 (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 20, as applied to Claim 17, neither Lalande nor Good disclose that the coating composition includes acrylated monomers and oligomers. Tighe discloses that the coating 20, which creates a coating composition with coating 30, includes oligomers which would also include acrylated monomers (Column 7, Lines 28 – 31). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and

substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner – July 19, 2006

Monica S. Carter
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